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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,939	02/24/2000	Ian Tomlinson	3789/86470	5170

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/511,939	<b>Applicant(s)</b> TOMLINSON ET AL.	
	<b>Examiner</b> Padmashri Ponnaluri	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☒ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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### **DETAILED ACTION**

The amendment and response filed on 10/10/03 have been fully considered and entered into the application.

Applicants in the response filed on 10/10/03 has stated that 'claims 15-32 withdrawn as non-elected.' Examiner would like to point out that claims 15-31 have been canceled by the amendment filed on 10/19/01. Applicants are requested to correct the status of the pending claims.

Declarations of Ian Tomlinson, and Greg P. Winter under 37 C. F. R 1.131 filed on 10/10/03 have been fully considered and entered into the application.

#### ***Status of the Claims***

This application contains claim 32 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

This application contains claim 32 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-31 have been canceled and claim 32 has been withdrawn and claims 33-52 are currently pending and are being examined in this application.

*Specification*

1. The disclosure is objected to because of the following informalities: the specification has been objected as the specification does not have a clear copy as set forth in the previous office action. Applicants were requested for a substitute copy of the specification.

Applicants in the response filed on 10/10/03 has stated that a substitute specification has been provided along with the response, however no copy is available. Applicants are requested to provide a new copy of substitute copy of the specification.

*Priority*

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in United Kingdom on 10/20/97, and 10/20/98. It is noted, however, that applicant has not filed a certified copy of the GB application as required by 35 U.S.C. 119(b).

3. If applicant desires priority under 35 U.S.C. 119 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_" should follow the filing date of the

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parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was

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unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### ***Drawings***

This application has been filed with informal drawings, which are acceptable for examination purposes only. Applicants are invited to notice the boxes checked by the draftsman in PTO-948.

### ***Claim Rejections withdrawn***

The rejection of claims 33-52 under 35 USC. 112 second paragraph have been withdrawn in view of amendments and response filed on 10/10/03.

The obviousness-type-double patenting rejection of record of claims 33-52 has been withdrawn in view of the terminal disclaimer filed on 10/10/03.

### ***Claim Rejections maintained***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The art rejections of claims 33-41 and 44-52 under 35 U. S.C. 102(e) as being anticipated by US Patent 6,057,098 (Buechler et al) set forth in the previous office action has been maintained for the reasons of record.

### ***Response to Arguments***

4. The declarations (both by Tomlinson and Winter) filed on 10/10/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Buechler et al reference.

Both the declarations by Tomlinson and Winter discuss the date the current invention was conceived and reduced to practice. The declaration by Tomlinson states that 'one area of polypeptide library technology that would benefit from a method that increases the proportion of functional and properly folded polypeptide is antibody library technology, because antibodies typically involve both heavy and light chain domains that each must be diversified and that each must properly fold in order to generate a functional molecule.' And further Dr. Tomlinson states that prior to April 1997, a process to overcome the problem by the inventors. A sublibrary of antibody heavy chains is selected for members that poorly fold, a sub-library of light chains is selected for members that poorly fold, and the two selected sublibraries are combined to form a library of antibodies that have been pre-selected for folded members that is then selected for binding to target antigen.' Thus the declarations are both directed to antibody libraries, whereas the instant independent claim is drawn to selecting peptides from a repertoire of polypeptides (different from the antibody library).

5. Applicant's arguments filed on 10/10/03 have been fully considered but they are not persuasive.

Applicants argue that Buechler et al is not prior art over the present application. Applicants argue that the accompanying Rule 131 Declarations of both inventors establish a date of conception prior to the April 4, 1997, effective filing date of the '098 reference. However, applicants response does not overcome the rejections of record for reasons discussed supra. Upon entering of the priority documents the rejections of claims 36-52 would be withdrawn, since the claims are drawn to antibody libraries or repertoires.

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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally be reached from Monday through Friday between 7.30 AM and 4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

  
Padmaashri Ponnaluri  
Primary Examiner  
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pp  
December 18, 2003